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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,394	07/03/2003	Matthias Gonschor	GK-ZEI-3195 / 500343.2020	4459
7590	05/03/2005		EXAMINER PRITCHETT, JOSHUA L	
REED SMITH LLP 599 Lexington Avenue New York, NY 10022-7650			ART UNIT 2872	PAPER NUMBER
DATE MAILED: 05/03/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,394

Applicant(s)

GONSCHOR ET AL.

Examiner

Joshua L. Pritchett

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

This action is in response to Amendment filed March 2, 2005. Claim 11 has been amended as requested by the applicant.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Sasaki (US 2002/0181096).

Regarding claim 1, Sasaki discloses a device for coupling in light for illumination a preparation in the beam path of a microscope (Fig. 1) which has an objective (14) and a tube lens (13) and a reflection light illumination device (Fig. 1) which comprises a light source (3) and a condenser (12), wherein the condenser images the light source in the field diaphragm plane and in so doing defines an optical axis (Fig. 1) comprising an at least partially reflecting element (10)

being provided in the vicinity of the field diaphragm plane and reflecting light from a second light source (2) into the beam path at a slight angle relative to the optical axis (Fig. 1).

Regarding claim 2, Sasaki discloses the second light source is a laser (Fig. 1).

Regarding claim 3, Sasaki discloses wherein the angle at which the light of the second light source is reflected into the beam path is adjustable (para. 0021). Sasaki states that the partially reflecting element (10) is rotatable therefore the partially reflecting element is capable of adjusting the angle of light reflected from the face of the partially reflecting element.

Regarding claim 4, Sasaki discloses the partially reflecting element reflects the light of the second light source into the beam path parallel to the optical axis (Fig. 1).

Regarding claim 5, Sasaki discloses the partially reflecting element is arranged at an angle of 45° to the optical axis (Fig. 1).

Regarding claim 6, Sasaki discloses a light conducting fiber (7) is provided which is held in such a way that the partially reflecting element is acted upon by the light of the second light source by an optical imaging system (Fig. 1).

Regarding claim 9, Sasaki discloses the optical imaging system can be focused (Fig. 1). Fig. 1 shows that the objective (14) focuses the light onto the object (15).

Regarding claim 10, Sasaki discloses the partially reflecting element, the holder of the light conducting fiber and the optical imaging system are combined in a mechanical unit (8; Fig. 1).

Regarding claim 11, Sasaki discloses the mechanical unit is constructed as a sliding unit (8; Fig. 1). Sasaki discloses the mechanical unit (8) is used as a scanning unit, which is capable of sliding different beam splitters into the beam path (para [0019-0020]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki in view of Hasegawa (US 6,792,138).

Regarding claim 7, Sasaki teaches the invention as claimed but lacks reference to the use of an inclination adjuster for the light conducting fiber. Hasegawa teaches the use of an inclination adjuster for a light conducting fiber in a microscope (col. 5 lines 57-65). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the Sasaki invention include the inclination adjuster of Hasegawa for the purpose of scanning the light from the light source across the objective.

Regarding claim 8, Sasaki teaches the holder of the light conducting fiber has a base inclination relative to the optical axis (Fig. 1).

Response to Arguments

Applicant's arguments, see Amendment, filed March 2, 2005, with respect to 35 U.S.C. 112 rejection of claim 11 have been fully considered and are persuasive. The 35 U.S.C. 112 rejection of claim 11 has been withdrawn.

Applicant's arguments filed March 2, 2005 have been fully considered but they are not persuasive.

On page 4, applicant argues that the Sasaki reference fails to teach or suggest, "at least one partially reflecting element positioned in the vicinity of the field diaphragm." The claim limitation does not include the phrase, "at least one partially reflecting element," the claim language instead reads as, "an at least partially reflecting element." The written claim limitation means that the reflecting element acts as to reflect at least some light but may be a totally reflecting element. Furthermore the phrase "in the vicinity" in the broadest reasonable interpretation allows the Sasaki reference to meet the current claim limitations.

On page 5, applicant argues that the Sasaki reference fails to teach the slight angle between the light source and the optical axis of the microscope. The claim limitation is written as "reflecting light from a second light source into the beam path at a slight angle relative to the optical axis." The examiner interprets this claim language to mean that the light is reflected at a slight angle, Fig. 1 shows that the partial reflector (10a) is at a slight angle, approximately 45-degreed, to the optical axis of the microscope.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

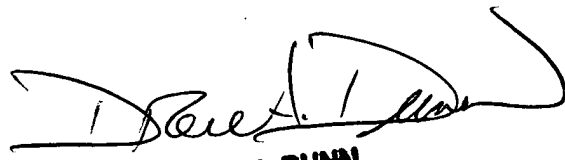
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2872

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP *JK*


DREW A. DUNN
SUPERVISORY PATENT EXAMINER